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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,960	12/31/2001	Andrew V. Anderson	42390.P9765x2	1569

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 06/09/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/039,960

Applicant(s)

ANDERSON ET AL.

Examiner

Bunjoo Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7, 8</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action has been reviewed; the objections and rejections cited are as stated below.
2. Applicant is required to submit a mark-up for a continuation-in-part application showing the subject matter added where there is an intervening reference (See. MPEP 704.11(a) (K).)
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features as amended to claims 1, 14 and 26 must be shown in the drawings or the feature(s) canceled from the claim(s). No new matter should be entered.

### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10, 18-28 and 34-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, or otherwise lacks patentable utility.
6. Claims 1-18 and 18-28 recite a method, which does not require any form of computer hardware software, to complete the task as recited in the claims. In other words, the method and apparatus as claimed can be done by a person pen or pencil and on papers. Beside, the process as claimed is a normal routine decision making, known to human as task management or task assignment. Since, the claims recited the known process, which did not require any form of compute hardware or instruction stored on a computer readable medium, as stated. Thus, claims 1-10 and 18-28 dictate a process that can be carried on by human being, per se, and constitutes non-statutory subject matter. See; inter alia, MPEP § 2106.

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7. As to claims 34-38 suffer deficiencies analogue to claims 18-28, i.e., an apparatus programmed could be a conventional task schedule listing on a paper, thus they also constitute non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 1, 11, 18, 29, 34 and 36, recite “the level” in line 3 or 4, there is insufficient antecedent basis for this limitation of the claims.

11. Claims 1, 11, 18 and 34, recite “the level of importance” in line 3-4 and “a level of importance”, thrice. It is indefinite, because it is not clear whether all four levels are referred to the same.

12. Claim 7 recites “a GPS receiver within the device” in line 1; there is insufficient antecedent basis for this limitation of the claims.

13. Claims 29 and 36, recite “the level of importance” in line 4 and “a level of importance”, in line 6, it is indefinite, because it is not clear whether they referred to the same level of importance.

14. Claims 34 and 36 recite “a first person”, thrice, it is indefinite, because it is not clear whether all three first persons, are the same.

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15. All dependent claims suffer analogous deficiencies; they are also rejected by the same rationale.

16. Applicant is requested to revise and provided a clear and concise claims language, in response to this Office Action. The response must include amendment of vague languages, in all claims, regardless the examiner has cited them.

17. For further examination purpose, 1-18, 18-28 and 34-38, are examined under presumption of being a computer method and apparatus.

### ***Double Patenting***

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See; 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Claims 1-38 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of co-pending Application No. 09/865,557. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instance claims merely adding threshold for determining importance of the event, without specifying how the threshold is derived, such limitation on reading event subject comparison.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Rejections - 35 USC § 102*

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

21. Claims 1-6, 8, 11-27, 29-32, 34 and 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Horvitz et al (US.2003/0046421).

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22. Regarding claims 1, 11 and 34, Horvitz discloses a method and system, including the use of computer software and hardware for function as an urgency messaging system, comprising:

receiving information of an event, (Fig. 1, Fig. 27);

determining the level of importance of the event relative to a first person, (paragraphs 9, 11, 14-15, 65);

if the event has a level of importance greater than, or equal to a first predetermined threshold, and a level of importance, that is below or equal to a second predetermined threshold, then select a person to contact and attempting to contact the person; and if the event has a level of importance greater than or equal to the second predetermined threshold, then selecting a plurality of persons to contact and attempting to contact the plurality of persons, (threshold range Fig. 11-12, paragraphs 11, 16, 69, 74, 76-78, 90, 103, 105, 108-108, 110, 112, 25, 275-277 and 279-380; claims, 7, 8, 52, 70, 72-73, 80-83).

23. Regarding claims 18, 22-27, 29 and 36-37, in addition to threshold implementation as discussed above, Horvitz further teaches that its invention has a capability of learning from feedback and adaptation in an appropriate way in according to the learning process, setting rule, implementing routing criteria in accordance with feedback from a client terminal, learning that the sent message failed to reached the user because he or she is away from the client device, and redirect the message to another specified client device , i.e., receiving failure in attempt to contact and determining a new appropriate course of action (see block 88-Fig. 1, profile setting and adjustment, fig. 2, altering option Fig. 3, paragraphs 14, 67-71, 103,-108).

24. Regarding claims 2, 12, 19 and 30, Horvitz discloses, comparing the subject of the event to a list of subjects of interest to the first person, (paragraphs 100, 111, 219).

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25. Regarding claims 3, 13, 20 and 31, Horvitz discloses, referring to information concerning the timing of activities in which a person is engaged, (paragraphs 100, 111, 219).

26. Regarding claims 4-5, 14-15, 21 and 32, Horvitz discloses, referring to information concerning the current location of a person, (Fig. 23-25; paragraphs 73, 115, 263, 264, 2701-271, 281 and 289).

27. Regarding claims 6, 16 and 17, Horvitz discloses, the system capable of located user, device whereabouts, i.e., current location of a person is provided by a device carried by the at least one person, (Fig. 34).

28. Regarding claims 38, Horvitz discloses, taking action without contact any person, e.g., the system employed threshold level for determining appropriate actions to be taken, e.g., such as sending notification without contact any one when threshold level is greater than 85 and less than maximum or send notification without contact any person when threshold level equal or higher than 95 and equal or below maximum, Fig. 23-26; paragraphs 17, 74-75, 83 and 105.

### ***Claim Rejections - 35 USC § 103***

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 7-10, 28, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al (US.2003/0046421), in view of what was well known in the art.



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31. Regarding claims 7, 9-10, Horvitz discloses the invention substantially, as claimed, as described in claim 6 but it does not explicitly include implementation of GPS device to locate a person. Official Notice is taken (see MPEP 2144.03) that using GPS device to specify location of a person was well known and widely implemented in the art at the time of the invention was made. Thus, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to expand a system that readily has a capability of locating user or any device carried by the user, such as suggested in Horvitz e.g., observing feedback from keyboard, mouse activity, or deriving user or device locations from predefined profile, by including a well-known device such as GPS to expand the utility ability and simplification of the system. The motivation to include the GPS device would to enhance system capacity, adaptability and competitiveness in the commercial market.

32. Regarding claims 28, 33 and 35, Horvitz discloses the invention substantially, as claimed, as described in their base claims, including event detection and redirect notification when message failed to reach the designate destination, user or device, but it is silent to applying such event detection in a case of one may choose not to respond. However, applying Horvitz system toward any desirable way include one who desire not to response is clearly not an invention, it merely an implementation choice, in which a notice in the art can modified with a minor attempt to apply in accordance with fluid situation.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bunjob Jaroenchonwanit  
Primary Examiner  
Art Unit 2143

/bj  
6/2/04